

Chadwick, et al.
U.S. Application No. 09/905,589

REMARKS

Claims 19-26 and 28-29 are pending in the application.

The Outstanding Rejections

The Examiner rejected claims 19-26 and 28-29 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,476,211 B1 (herein referred to as the '211 patent).

Patentability Arguments

1. 35 U.S.C. §102(e) Rejection

Applicants respectfully traverse and submit that the claimed invention of CD39L2 antibodies and the subject matter disclosed in the '211 patent were subject to obligation of assignment to Hyseq, Inc. (now Nuvelo, Inc.) at the time of filing the instant application. Both the '211 patent and the parent application of the instant application, U.S. Patent No. 6,350,447, were subsequently assigned to Hyseq, Inc. (Reel/Frame: 012324/0862 and 01374/0667, respectively). As such, the disclosed but not claimed subject matter in the '211 patent should not preclude patentability of the CD39L2 antibodies of the instant application. Therefore, any invention disclosed but not claimed in the '211 patent was derived from the inventors of the instant application and is thus not an invention by another. Thus, in light of the aforementioned remarks, the rejection under 35 U.S.C. §102(e) is moot and should be withdrawn. Furthermore, as requested by the Examiner in the Advisory Action mailed September 2, 2004 and as discussed with the Examiner by telephone on September 15, 2004, Applicants herein submit a copy of the Rule 1.132 declaration of Walter Funk, Ph.D. dated September 15, 2004 (herein referred to as the Funk Declaration) regarding common assignment of the instant invention and the '211 patent.

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CONCLUSION

On the basis of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims are in condition for allowance, and a Notice of Allowance is respectfully requested as soon as possible. If there are any questions regarding these amendments and remarks, or if further discussion would expedite allowance of the claims, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

Date: September 15, 2004

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